UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte VIPUL V. PRAKASH

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Appeal 2009-007309[1]
Application 10/799,860
Technology Center 2400

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Before JEAN R. HOMERE, ST JOHN COURTENAY III, and
DEBRA K. STEPHENS, *Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL[2]

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I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1-20. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse.

Appellant's Invention

Appellant invented a method of screening an electronic communication by determining whether uniform resource locators (URLs) contained therein are of a predetermined category. (Spec. 3, ¶ [0007]). In particular, upon extracting the URLs from the electronic communication, the length of the communication and the extracted URLs are used in order to generate one or more digital signatures therefor. (Spec. 7, ¶ [0021]).

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method comprising:

> extracting URLs from electronic communication; and

> analyzing the URLs extracted to determine whether the electronic communication is of a first predetermined category, said analyzing comprising generating one or more signatures using a length of the electronic communication and the URLs extracted.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of

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unpatentability:

      Aronson   US 6,654,787 B1   Nov. 25, 2003

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1.   Claims 1, 5, 10 and 15 stand rejected under 35 U.S.C. § 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter, which Appellant regards as the invention.

2.   Claims 1-4 and 6-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Aronson.

Appellant's Contentions

Appellant contends that the Examiner's assigned non-numerical meaning of the term "length" is not reasonable in light of the specification, which describes the cited term as a numerical value used in an equation to determine the digital signature of an electronic communication associated therewith. (App Br. 10-12, Reply Br. 2-4.). Consequently, Appellant submits that the Examiner's rejections are in error since they both rely upon the Examiner's unreasonable interpretation of the term "length" as recited in independent claim 1. (*Id.*)

Examiner's Findings and Conclusions

The Examiner finds that the term "length" is ambiguous since it can be interpreted both as a numerical value or a non-numerical value. Further, the Examiner submits that one of ordinary skill would not be apprised of the

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scope of the invention since the Specification does not provide a standard for ascertaining a requisite degree for the cited term. Consequently, the Examiner finds that Aronson's disclosure of extracting URLs from an electronic communication teaches generating a signature using the length of the communication and the URLs extracted therefrom, as recited in independent claim 1. (Ans. 2-3, 6-7.)

II. ISSUE

Have Appellants shown that the Examiner erred in finding that the term "length" is ambiguous, and that Aronson's disclosure thereby teaches using the length of an electronic communication and URLs extracted therefrom to generate a signature, as recited in independent claim 1?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1.   Appellant's Specification states in relevant parts that:

> To generate signatures, processing logic may perform various computations or hashing on the URLs extracted. For example, in one embodiment, processing logic computes a SHA1 hash over the hostname extracted and uses the first 48 bits of the hash result as the first part of a signature. *Processing logic may derive the next 16 bits of the signature from the length of the electronic communication.* For example, *the length-may be computed using the following formulae*:
>
> length=orig_length-orig_length % 100), where % is the remainder of integer division; length=length<100?100: length, if length is less than 100, then length should be set to 100, otherwise, the original value of

length should be retained. In the above example, the resultant length would be a multiple of 100.

(Spec., ¶¶ [0021-22]). Emphasis added.

2. Aronson discloses a server for filtering according to predetermined criteria e-mail messages retrieved from a mail server. (Abst.) In particular, Aronson discloses a filter module that filters spam based on a mathematical signature, which may include feature extraction and analysis such as URL, phone numbers. (Col. 5, ll. 50-64, col. 6, ll. 1-6.)

IV. ANALYSIS

Independent claim 1 requires, *inter alia*, generating a signature using a length of an electronic communication and extracted URLs. (Br. 14, Claims App'x.)

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).[3] The claim as a whole must be considered to determine whether it apprises one of ordinary

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[3] "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir.1991)). The "inquiry therefore is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity." *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

skill in the art of its scope, and therefore serves the notice function required by 35 U.S.C. § 112, second paragraph by providing clear warning to others as to what constitutes the infringement of the patent. *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 (Fed. Cir. 2000.) If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claims so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. § 112, second paragraph is deemed appropriate. *Morton Int'l, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 1470 (Fed. Cir. 1993).

As set forth in the Findings of Fact section, Appellant's Specification indicates that a length of the electronic communication is computed in a formula in order to generate a signature. (FF. 1.) We find that one of ordinary skill having read Appellant's Specification would have been readily apprised of the scope of the disputed language. In other words, the ordinarily skilled artisan would have appreciated that the length of the document in question refers to a numerical value designating a measure of distance or dimension, which can be plausibly used in the signature computation equation. Consequently, we agree with Appellant that the Examiner's interpretation of the disputed term as being directed to a non-numerical value is inconsistent with the Specification, and thereby unreasonable. It follows that Appellant has shown that the Examiner erred in concluding that claims 1, 5, 10 and 15 are indefinite.

Next, as set forth above, Aronson discloses filtering received e-mail communications based on certain predetermined rules including generating a

signature, which may entail extracting URLs. (FF. 2.) We find that while Aronson teaches generating a signature to filter an electronic document, the computation of the signature merely includes the extraction of URLs, but not the numerical length of the electronic document. Consequently, we agree with Appellant that Aronson does not teach the disputed limitations.

Since Appellant has shown at least one error in the Examiner's anticipation rejection of claim 1, we need not address Appellant's other arguments. It therefore follows that Appellant has shown that the Examiner erred in finding that Aronson anticipates independent claim 1.

Since claims 2-4 and 6-20 recite the limitations of claim 1 discussed above, we find that Appellant has shown error in the Examiner's rejection of these claims for the same reasons set forth above.

V. SUMMARY

Appellant has established that the Examiner erred in rejecting (1) claims 1, 5, 10 and 15 as being indefinite, and (2) claims 1-4, 6-20 under 35 U.S.C. § 102(a) as being anticipated over Aronson. We therefore reverse these rejections.

REVERSED

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